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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,884	05/21/2001	Kenneth L. Davis	30566.128-US-01	6589
22462	7590	08/23/2004	EXAMINER	
GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/862,884

Applicant(s)

DAVIS, KENNETH L.

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/27/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to application filed 05/21/2001.
2. Claims 1-24 are pending. Claims 1, 9, and 17 are independent claims.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6, 9-14, and 17-22 are rejected under 35 U.S.C. 102(b) as being unpatentable by Covington et al. US Patent No. 5,524,193 issued 06/14/1996 filed 09/2/1994 (hereinafter '193).**

**In regard to independent claim 1,** *"(a) obtaining a sequence of frames to be consecutively displayed on a display device, wherein a frame comprises one or more images", as taught by '193 at col. 1, line 60 through col. 2; line 5 (i.e....that is a peace of ...audio or video clip) may be referred to a "media event"...display under any topic of the computer base...video segment display...), also at col. 5, lines 25-30 (i.e.... on a color monitor...), "(b) obtaining annotation information, wherein the annotation information comprises: (ii) an annotation," as taught by '193 at col. 4, lines 40-45 (i.e....annotated with text, video...); "(i) an identification of a frame; and (iii) a location on*

*the identified frame to display the annotation*", as taught by '193 at col. 9, line 50 through col. 10; line 30 (i.e....that is a piece of each reel is divided into a number of different partitions, call "frames"...in FIG. 5, each of the Library reel, Clip Reel, and Event Reel are divided into six frames...if the event is graphic event...the bitmap, vector map... The Library, Clip and Event Reels 510, 520 and 530, respectively, provide a means for identifying and selecting individual or groups of events from among the thousands that may be available, for inspecting them, modifying them or creating new events, and for assembling a sequence of events that may be connected to a trigger) may be referred to a "media event"...display under any topic of the computer base...video segment display...), *"(c) consecutively displaying one or more of the sequence of frames until the identified frame is displayed; (d) pausing the display of the sequence of frames when the identified frame is displayed"*, as taught by '193 at col. 12, line 63 through col. 13, line 14 (i.e....Play button 820a to 820e allow user to scan the video...820c stop the play back...); *"(e) displaying the annotation at the location"*, as taught by '193 at col. 2, lines 48-60 (i.e.... provides to users (...the ability to create sequences of media events that are connected to and accessible from other media events, and the ability to change existing annotating sequences. The media events (e.g., a piece of text, an illustration, an audio or video clip, may be referred to as a "media event" or simply an "event") used in a given sequence may be selected from a library of media events, or may be created by a user from scratch or by modifying existing media events. Also, each media event used in the annotation sequence may itself be annotated...).

**In regard to dependent claim 2**, "*the annotation comprises text*", as taught by '193 at col. 4, lines 40-45 (i.e.... annotated with text...).

**In regard to dependent claim 3**, "*the annotation comprises an arrow*", as taught by '193 at col. 4, lines 50-65 (i.e.... two arrow buttons ...).

**In regard to dependent claim 4**, "*the annotation comprises a primitive shape*", as taught by '193 at col. 16, lines 1-5 (i.e. the graphics editor shown in FIG. 11 does not provide for changing the graphic bitmap shown in display area 1110. It only allows the bitmap to be incorporated in the graphic event being created as a whole).

**In regard to dependent claim 5**, "*the sequence of frames comprises an animation*", as taught by '193 at col. 1, lines 30-35 (i.e. ... either still or animated...).

**In regard to dependent claim 6**, "*the sequence of frames comprises a video*", as taught by '193 at col. 2, lines 53-60 (i.e. ... annotating...media event or events (e.g., a piece of text, an illustration, an audio or video clip, may be referred to as a "media event" or simply an "event"))).

**In regard to independent claim 9**, is directed to an apparatus for performing the method of claim 1, and is similarly rejected along the same rationale.

**In regard to dependent claims 10-14 consecutively**, are directed to an apparatus for performing the method of claims 2-6 consecutively, and are similarly rejected along the same rationale.

**In regard to independent claim 17**, is directed to a computer readable medium for performing the method of claim 1, and is similarly rejected along the same rationale.

**In regard to dependent claims 18-22 consecutively**, are directed to a computer readable medium for performing the method of claims 2-6 consecutively, and are similarly rejected along the same rationale.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 7, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable by Covington et al. US Patent No. 5,524,193 issued 06/14/1996 filed 09/2/1994 (hereinafter '193), in view of Gupta et al. US Patent No. 6,484,156 B1 issued 11/19/2002 filed 09/15/1999 (hereinafter '156).**

**In regard to dependent claim 7**, '193 does not explicitly teach, "*the annotation information is defined in conformance with an extensible markup language (XML) schema*", however, as taught by '156 at col. 6, lines 5-15 (i.e..... an annotation server and a client computer...using Extensible Markup Language (XML)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a feature, wherein the annotation information is defined in conformance with an extensible markup language (XML). One of the ordinary skills in

the art would have been motivated to perform such a modification to synchronize the media composition frameworks implied by MPEG-4, Dynamic HTML, other media playback environments (multimedia presentation may also include "annotation"), as taught by '156 at col. 1, lines 35-65 (i.e....allowing the presentation data...).

**In regard to dependent claim 15**, is directed to an apparatus for performing the method of claim 7, and is similarly rejected along the same rationale.

**In regard to dependent claim 23**, is directed to a computer readable medium for performing the method of claim 7, and is similarly rejected along the same rationale.

6. **Claims 8, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable by Covington et al. US Patent No. 5,524,193 issued 06/14/1996 filed 09/2/1994 (hereinafter '193), in view of Chang et al. US Patent No. 6,584,479 B2 issued 06/24/2003 filed 06/17/1998 (hereinafter '479).**

**In regard to dependent claim 8**, '193 does not explicitly teach, "*overlaying the annotation on the paused frame at the location*", however, as taught by '479 at col. 3, lines 30-35 (i.e..... To aid in creating the annotation, the screen-displayed body of primary data is modified. Modification can include overlay presentations in which the area to be annotated...).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a feature, wherein the annotation is overlaying on the pause frame at the location. One of the ordinary skills in the art would have been motivated to perform such a modification to enabling a user friendly tool to aid user to



dynamically display the supplementary textual or graphical annotations over a primary source, as taught by '479 at col. 1, lines 5-10 (i.e....dynamic display...).

**In regard to dependent claim 16**, is directed to an apparatus for performing the method of claim 8, and is similarly rejected along the same rationale.

**In regard to dependent claim 24**, is directed to a computer readable medium for performing the method of claim 8, and is similarly rejected along the same rationale.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Qian et al        U.S. Patent No. 6,070,167        issued 05/30/2000    filed 03/02/1998

Demello et al    U.S. Patent No. 6,714,214B1    issued 03/30/2004    filed 12/07/1999

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781, **"After mid-Oct, 2004, the examiner can be reach at (571) 272- 4103"**. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.  
Status information for unpublished applications is available through Private PAIR only.  
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

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**Quoc A. Tran**  
**Patent Examiner**  
**Technology Center 2176**  
**August 17, 2004**

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**